



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,057	04/24/2001	Kenji Matsuoka	04329.2561	3706

7590 12/06/2004

Finnegan, Henderson, Farabow
Garrett & Dunner, L.L.P.
1300 I Street, N.W.
Washington, DC 20005-3315

EXAMINER

LIN, WEN TAI

ART UNIT	PAPER NUMBER
----------	--------------

2154

DATE MAILED: 12/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/840,057

Applicant(s)

MATSUOKA, KENJI

Examiner

Wen-Tai Lin

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 7-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/24/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's election of claims 1-6 in the response dated 8/20/2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP 818.03(a)).
2. Claims 7-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention.
3. Claims 1-6 are presented for examination.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2154

5. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dancs et al. (hereafter "Dancs") [U.S. Pat. No. 6385651], in view of STARWEB [JP-2001265912A] and Stewart et al. (hereafter "Stewart") [U.S. Pat. No. 6732176].

6. As to claim 1, Dancs teaches the invention substantially as claimed including: a method of an Internet connection information registration service [Abstract; Figs. 1 and 3-5], comprising the steps of:

performing a service for registering Internet connection information for Internet connection on a portable recording medium [102, Fig. 1; i.e., the smart card] by a write terminal [101, Fig. 1] and is capable of connecting the portable recording medium while the portable recording medium is being connected to the write terminal [Abstract: lines 4-19];

Dancs does not specifically teach that the above registration process is performed at a write terminal [i.e., a computer client device] that is installed in a store, wherein the store obtains a predetermined compensation from a provider selected by a user.

However, STARWEB teaches that business model exists for paying remuneration to stores or persons who introduce new subscribers to a fee service provision system in Internet [page 1]. Further, Stewart; teaches that local wireless network maintainer may provide a mechanism for users to register or subscribe to an external network provider, e.g., an external ISP, and receive referral fee [Stewart;: col.15, lines 40-47].

Art Unit: 2154

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Dancs, STARWEB and Stewart; by allowing network service stores to register new subscribers for selected ISP and obtaining predetermined compensation from the provider because by doing so it would promote broader use of the selected ISP.

7. As to claim 2, Dancs does not specifically teach that the registration service involves a developer who provides the system (i.e., both software and hardware) that is necessary to perform the service. However, Stewart teaches that the business model as mentioned provides a stable numeration payment system according to each person's effort [see Stewart's "ADVANTAGE" paragraph on page 1].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to also compensate the developer of the Internet connection information registration service because the developer's effort also contributes to the Internet provider's revenue and therefore should also receive proper compensation in accordance with Stewart's business model, wherein all the relevant parties get compensated in accordance with their contribution.

8. As to claim 3, Dancs further teach the step of sending a notification representing completion of registration of the Internet connection information on the portable recording medium by the write terminal from the terminal [note that this is an inherent step when a registration is completed].

Art Unit: 2154

Dancs does not specifically teach that notification representing completion of registration is sent to an agreement count apparatus of the Internet connection information registration service developer for counting the number of subscribers to each provider in units of stores, and periodically sending a count result from the agreement count apparatus as basis for calculation of the compensation. However, Stewart teaches that the business model as mentioned adds each new subscriber to a branch of tree structure, of a person who introduces the subscriber [See Stewart's "Novelty" paragraph of page 1]. As such, it is clear that Stewart's remuneration is calculated based upon the number of new subscribers being brought into to the ISP service.

It would have been obvious to one of ordinary skill in the art that (1) the best time to count a new subscriber is at the completion of registration because this is the event that a new subscriber gets to be recognized by the selected ISP; (2) the counting can be performed periodically, because Stewart's business model is built on stable network environment wherein contribution can be naturally accumulated and rewarded periodically [see Stewart's "ADVANTAGE" paragraph on page 1].

9. As to claims 4-6, since the features of these claims can also be found in claims 1-3, they are rejected for the same reasons set forth in the rejection of claims 1-3 above.

Art Unit: 2154

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Fuller et al. [U.S. PGPub 20030101092];

Muller; et al. [U.S. Pat. No. 6356541];

Boyles; et al. [U.S. Pat. No. 6738901]; and

Mikurak [U.S. PGPub 20040064351].

11. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 days from the mail date of this letter. Failure to respond within the period for response will result in ABANDONMENT of the application (see 35 U.S.C. 133, M.P.E.P. 710.02, 710.02(b)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wen-Tai Lin whose telephone number is (571)272-3969. The examiner can normally be reached on Monday-Friday (8:00-5:00) .

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571)272-3964. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(703)872-9306 for official communications; and

(571)273-3969 for status inquires draft communication.

Art Unit: 2154

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wen-Tai Lin

December 1, 2004

Wen-Tai Lin
12/1/04